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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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David J. Lutz

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EXAMINER

CAJILIG, CHRISTINE T

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3637

MAIL DATE

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09/13/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/761,830	Applicant(s) LUTZ, DAVID J.	
	Examiner Christine T. Cajilig	Art Unit 3637	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-21 is/are pending in the application.
- 4a) Of the above claim(s) 12-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 12-16, drawn to a system for venting, classified in class 454, subclass 356.
- II. Claims 16-21, drawn to a ventilation pipe protector, classified in class 52, subclass 198.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require that the orifices be spaced throughout the length of the pipe plug. The subcombination has separate utility such as being used as a shower drain cap.

The examiner has required restriction between combination and subcombination inventions. Where applicant elects a subcombination, and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or

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includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

Newly submitted claims 12-16 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the combination as claimed does not require the particulars of the subcombination and the subcombination has separate utility as discussed above.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 12-16 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Objections

Claims 18-21 are objected to because of the following informalities: The preamble of the claims should read as "--The ventilation pipe protector of claim--" because it is the protector being claimed in independent claim 17 and not a system. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 17 and, accordingly, all claims dependent therefrom are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 17, the use of the word "its" in lines 6 and 10 of the claim renders the scope of the claim to be indefinite. It is unclear as to what exact element is being referred to by the word "its," (i.e. the neck, head, or sleeve, or the neck, head, and sleeve).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 17 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Hernandez (U.S. Pub. No. 2003/0110554 A1).

Regarding claim 17, Hernandez in Figure 6 discloses a ventilation pipe protector adaptable to a ventilation pipe for venting of gas and preventing ingress of animals and debris, comprising: a pipe plug (10') adapted to be mounted on a top opening in a ventilation pipe, the pipe plug comprising a tubular sleeve (14') transitioning in diameter to a larger conical neck (58) transitioning in diameter to a still larger hollow head (60), said plug comprising a plurality of ventilation orifices (f, 18') spaced throughout a length sized small enough to prevent ingress of animals and debris and still vent gas; the pipe plug inherently has a means for accommodating a wide variety of sized ventilation pipes due to the shape of the pipe plug and would be adapted to fit a range of ventilation pipe openings due to the neck portion (58). The language of "when mounted on a ventilation pipe," "when mounted on a top opening of a ventilation pipe with at least a portion of the neck adapted to extend therein resulting in a low tolerance fit for a variety of ventilation pipe sizes", and "when inserted within a ventilation pipe to fit a variety of ventilation pipe sizes by leaving an appreciable gap bounded by the tubular sleeve, the conical neck, and a ventilation pipe, wherein the plurality of ventilation orifices also vent gas which may be trapped in said gap" are regarded as functional language and while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than

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function. Examiner refers Applicant to MPEP §2114. Furthermore, the pipe plug of Hernandez is capable of performing the functions stated above.

Regarding claim 18, Hernandez, in Figure 6, discloses a ventilation pipe protector wherein said hollow head comprises (60) a convex shaped top end (60).

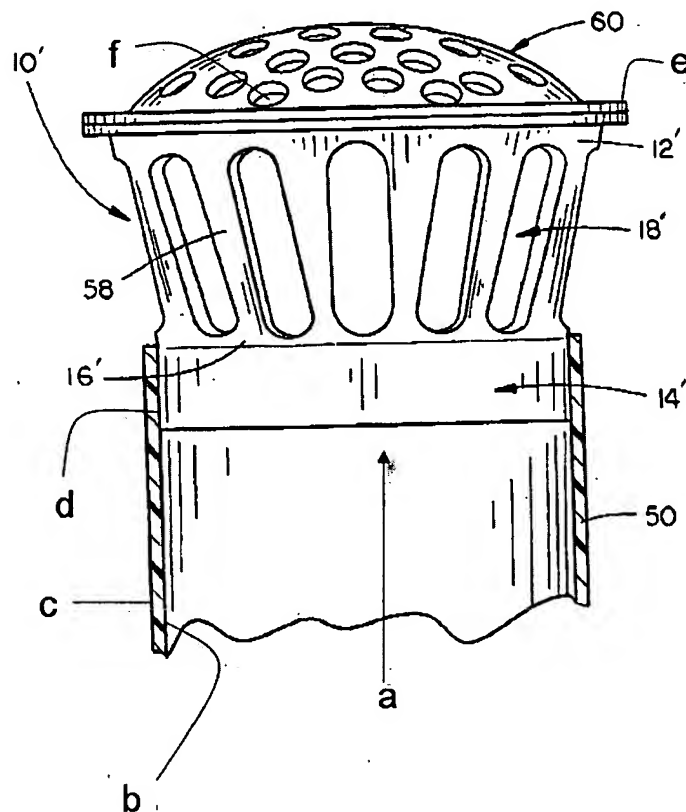


FIG. 6

Hernandez (U.S. Pub. 2003/0110544 A1)

Claim 17 is rejected under 35 U.S.C. 102(e) as being anticipated by Howson (U.S. Patent No. 6,799,606).

Regarding claim 17, Howson, in Figure 8, discloses a ventilation pipe protector adaptable to a ventilation pipe for venting of gas and preventing ingress of animals and debris, comprising: a pipe plug adapted to be mounted on a top opening in a ventilation pipe, the pipe plug comprising a tubular sleeve (12) transitioning in diameter to a larger conical neck (26) transitioning in diameter to a still larger hollow head (50), said plug comprising a plurality of ventilation orifices (52) spaced throughout a length sized small enough to prevent ingress of animals and debris and still vent gas; the pipe plug inherently has a means for accommodating a wide variety of sized ventilation pipes due to the shape of the pipe plug and would be adapted to fit a range of ventilation pipe openings due to the neck portion (26). The language of "when mounted on a ventilation pipe," "when mounted on a top opening of a ventilation pipe with at least a portion of the neck adapted to extend therein resulting in a low tolerance fit for a variety of ventilation pipe sizes", and "when inserted within a ventilation pipe to fit a variety of ventilation pipe sizes by leaving an appreciable gap bounded by the tubular sleeve, the conical neck, and a ventilation pipe, wherein the plurality of ventilation orifices also vent gas which may be trapped in said gap" are regarded as functional language and while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. Examiner refers Applicant to MPEP §2114. Furthermore, the pipe plug of Hernandez is capable of performing the functions stated above.

Alternatively, Claims 17, 18, and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Nowell (U.S. Patent No. 6,912,739 B1).

Regarding claims 17, 18, and 20, Nowell in Figure 4 discloses a pipe plug (62) adapted to be mounted on a top opening in a ventilation pipe, the pipe plug comprising a tubular sleeve (68) transitioning in diameter to a larger conical neck (transition at 76) transitioning in diameter to a still larger hollow, convex shaped head (70), said plug comprising a plurality of ventilation orifices (74, 65) spaced throughout a length of the plug sized small enough to prevent ingress of animals and debris and still vent gas; the pipe plug inherently has a means for accommodating a wide variety of sized ventilation pipes due to the shape of the pipe plug and would be adapted to fit a range of ventilation pipe openings due to the transitional neck portion (76), the plurality of orifices are circular in cross section and about 3 mm in diameter (See Col 3, Ln 28-29 where the openings are 1/8" which is about 3mm). The language of "when mounted on a ventilation pipe," "when mounted on a top opening of a ventilation pipe with at least a portion of the neck adapted to extend therein resulting in a low tolerance fit for a variety of ventilation pipe sizes", and "when inserted within a ventilation pipe to fit a variety of ventilation pipe sizes by leaving an appreciable gap bounded by the tubular sleeve, the conical neck, and a ventilation pipe, wherein the plurality of ventilation orifices also vent gas which may be trapped in said gap" are regarded as functional language and while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure

rather than function. Examiner refers Applicant to MPEP §2114. Furthermore, the pipe plug of Hernandez is capable of performing the functions stated above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hernandez ('554 A1) in view of McDonald (U.S. Patent No. 5,291,707).

Regarding claim 19, Hernandez discloses the limitations as discussed above, but does not disclose said hollow head comprising an apex end opposite an end of said hollow head attached to the sleeve. However, McDonald in Figure 3, teaches a vent bird protector with a head (36) comprising an apexed end (26) opposite an end of said hollow head attached to the sleeve (39). Therefore, it would have been obvious to a person having ordinary skill in the arts at the time of the applicant's invention to modify the ventilation pipe protector of Hernandez to include a head comprising a peaked end opposite an end of said hollow head attached to the sleeve as taught by McDonald to prevent birds from perching on the stack (Col 1, Ln 58-60).

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hernandez ('554 A1).

Regarding claim 20, Hernandez discloses the limitations as discussed above, and further discloses that the ventilation orifices (f) are circular in cross section but does not disclose that the ventilation orifices are about 3 millimeters in diameter. It would have been an obvious matter of design choice to modify the ventilation orifices (f) of Hernandez to have a diameter of about 3mm since such a modification would have involved a mere change in the size of the components. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hernandez ('554 A1) in view of Brenner (U.S. Patent No. 2,768,007).

Hernandez discloses the limitations as discussed above, but does not disclose a collar surrounding the conical neck. However, Benner in Figure 9, teaches a washer (20) disposed a conical neck (18) of a pipe. Therefore, it would have been obvious to a person having ordinary skill in the arts at the time of the applicant's invention to modify the ventilation pipe protector of Hernandez to include a collar surrounding the conical neck as taught by Benner to allow any diameter sleeve and head to fit into a pipe with a larger diameter without falling through (Col 2, Ln 30-37). The phrase "such that the collar rests atop the ventilation pipe opening in the event the ventilation pipe opening is larger than the hollow head and prevents the pipe protector from slipping into the pipe"

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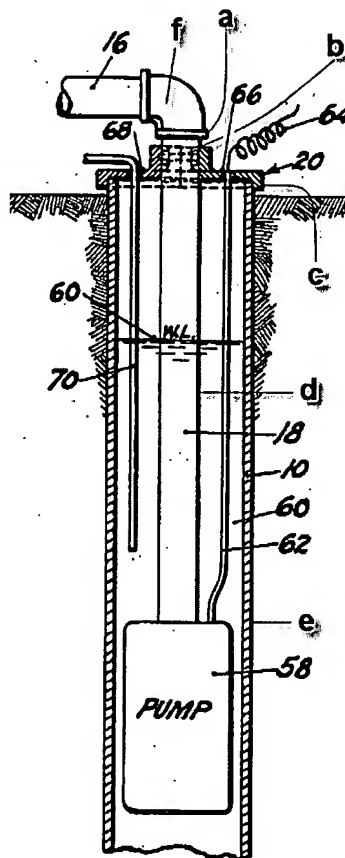
is regarded to as functional language, and while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. Examiner refers Applicant to MPEP §2114. Furthermore, pipe plug of Hernandez in view of Brenner is capable of performing the functions stated above.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Howson (U. S. Patent No. 6,799,606).

Regarding claim 21, Howson discloses the structure as discussed above but does not disclose that the plug further comprises a collar surrounding the conical neck. However, Howson also discloses the use of a collar 88 that contacts the underside of head 14 as shown in the embodiment of Figure 10. Therefore, it would have been obvious to a person having ordinary skill in the arts at the time of the Applicant's invention to modify the Figure 6 embodiment of Howson to include a drain collar 88 as shown in the Figure 10 embodiment of Howson to provide a seal. Per such modification collar 88 would contact the neck portion 26 of Figure 8.). The phrase "such that the collar rests atop the ventilation pipe opening in the event the ventilation pipe opening is larger than the hollow head and prevents the pipe protector from slipping into the pipe" is regarded to as functional language, and while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than

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function. Examiner refers Applicant to MPEP §2114. Furthermore, pipe plug of Howson is capable of performing the functions stated above.

**FIG. 9**

Brenner (U.S. Patent No. 2,768,007)

Alternatively claims 17, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holland (U.S. Patent No. 1,573,067) in view of Shyh (U.S. Patent No. 5,284,580).

Regarding claim 17, Holland discloses a ventilation pipe protector adaptable to a ventilation pipe for venting of gas and preventing ingress of animals and debris, comprising: a pipe plug adapted to be mounted on a top opening in a ventilation pipe, the pipe plug comprising a tubular sleeve (4) transitioning in diameter to a larger conical neck (5) transitioning in diameter to a still larger hollow, apex shaped head (6), said plug comprising a plurality of ventilation orifices (10, 14) spaced throughout a length of the neck and head sized small enough to prevent ingress of animals and debris and still vent gas; the pipe plug inherently has a means for accommodating a wide variety of sized ventilation pipes due to the shape of the pipe plug and would be adapted to fit a range of ventilation pipe openings due to the neck portion (5), but does not disclose a plurality of orifices spaced throughout the tubular sleeve. However, Shyh discloses a drain cover and filter comprising a plurality of openings (see 11' on Figure 2) spaced throughout the length of the sleeve and a bottom basin. Therefore, it would have been obvious to a person having ordinary skill in the arts at the time of the Applicant's invention to modify the structure of Holland to have a plurality of ventilation orifices spaced throughout a length of the sleeve with a bottom basin as taught by Shyh to provide further filtering means to prevent debris from entering a pipe. The language of "when mounted on a ventilation pipe," "when mounted on a top opening of a ventilation pipe with at least a portion of the neck adapted to extend therein resulting in a low tolerance fit for a variety of ventilation pipe sizes", and "when inserted within a ventilation pipe to fit a variety of ventilation pipe sizes by leaving an appreciable gap bounded by the tubular sleeve, the conical neck, and a ventilation pipe, wherein the

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plurality of ventilation orifices also vent gas which may be trapped in said gap” are regarded as functional language and while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. Examiner refers Applicant to MPEP §2114. Furthermore, the pipe plug of Hernandez is capable of performing the functions stated above.

Regarding claim 20, Holland already modified by Shyh discloses the limitations as discussed above, and further discloses that the ventilation orifices (f) are circular in cross section but does not disclose that the ventilation orifices are about 3 millimeters in diameter. It would have been an obvious matter of design choice to modify the ventilation orifices (f) of Holland already modified by Shyh to have a diameter of about 3mm since such a modification would have involved a mere change in the size of the components and alter the filtering tolerance. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Response to Arguments

Applicant's arguments with respect to claim 17 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christine T. Cajilig whose telephone number is (571) 272-8143. The examiner can normally be reached on Monday - Friday from 9am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on (571) 272-6867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CTC/
09/04/07

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